

### **THE AMENDMENT**

Claims 1-8 and 10-28 are in the case. Claims 1, 10, 16, 17 and 21 have been amended. Claim 9 has been cancelled.

The amendment to claim 17 is to correct a grammatical error that is obvious from its context. The amendment to claim 10 is to provide proper antecedent basis with the appropriate parent claim after cancellation of claim 9.

Support for the amendment to claim 1 regarding a “game apparatus (element D)” is based on cancelled claim 9. Support for the amendments to claims 1, 16 and 21 regarding “randomly determining a game outcome”; “partially conveying the randomly determined game outcome to the player”; and using a “controller to randomly determine the game outcome” can be found at ¶[29] (page 5) and at ¶[59] (page 9) of the original Specification.

Applicants respectfully submit that the Amendment does not introduce new matter and request that the Amendment be entered.

### **REMARKS**

#### **1. A Brief Summary of One Embodiment of Applicants' Invention**

In one embodiment, the present invention is directed to a gaming device involving a three-dimensional figure comprising a plurality of three-dimensional sections, each having a height, a width, and a depth. At least one three-dimensional section is moveable relative to the other three dimensional sections and comprises a plurality of three-dimensional fractional images. The moveable three-dimensional section may be positionable to allow a player to view the plurality of three-dimensional fractional images by moving the moveable three-dimensional section. When the moveable three-dimensional section is in at least one position, the plurality of three-dimensional sections forms at least one whole, integrated three-dimensional image. The

gaming device also comprises an actuator attached to the moveable three-dimensional section that is configured to move the moveable three-dimensional section. The gaming device also includes a controller in communication with the actuator and configured to randomly determine a game outcome and to cause the actuator to move the moveable three-dimensional section.

**2. Rejection of claims 1-6 and 13-14 under 35 USC §103(a) as obvious over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131).**

Claims 1-6, 13 and 14 stand rejected under 35 USC §103(a) as being obvious over Lupo in view of Horvath. Applicants respectfully traverse the rejection.

Lupo appears to disclose a three-dimensional Tic-Tac-Toe-type computer game depicting a rotatable playing structure and a number of separate substructures, where each substructure within the playing structure has mutable characteristics when viewed prospectively on the computer. Lupo appears to teach games that depend on logic and deductive skills (see Abstract) where each player is competing with another game player or the game controller; as such, Lupo does not deal with activities that involve games of chance, i.e., dependent upon randomly determined game outcomes.

Horvath appears to disclose an improved puzzle device where groups of elements are rotatable about selected orthogonally related axes to move the elements into predetermined relationships. Horvath also appears to teach puzzles that would involve attributes of individual skill, as opposed to games of chance.

Applicants respectfully submit that newly amended independent claim 1 is based on randomly determined game outcomes, i.e., where causing, deciding, dictating, choosing, selecting or affecting the outcome of the game generates a randomly determined game outcome

as part of the game of chance; this is to be contrasted with games of skill, e.g., where the player may manipulate factors and elements directly affecting the game outcome. Randomly determining a game outcome may also to be contrasted with simply detecting, learning, identifying, discovering, ascertaining or finding out the result of a game.

Applicants respectfully submit that claim 1 (and its corresponding dependent claims) are not obvious over Lupo in view of Horvath, since neither Lupo nor Horvath, either alone or in combination, teach or suggest all the limitations of Applicants' claimed invention, in particular, the involvement of randomly determined game outcomes (Lupo and Horvath actually teach away from, or are silent on, randomly determined game outcomes). Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 1-6 and 13-14 under 35 USC §103(a).

**3. Rejection of claims 16-19, 21-23, 25 and 26 under 35 USC §103(a) as being obvious over Kaplan (U.S. Patent No. 5,413,342) in view of Horvath (U.S. Patent No. 4,405,131).**

Claims 16-19, 21-23, 25 and 26 stand rejected under 35 USC §103(a) as being obvious over Kaplan in view of Horvath. Applicants respectfully traverse the rejection.

Kaplan appears to disclose a slot machine with three or more moving elongated reels which are parallel with each other in a horizontal position that stop at arbitrary times; the reels include several kinds of graphic patterns (two-dimensional) which depict wins by the number of matched patterns. A housing encloses the reels with a glass display having triangular viewing windows through which the graphic patterns are displayed. Each triangular viewing window is placed to form a larger triangle and provide a PYRAMID game format.

Horvath appears to disclose an improved puzzle device where groups of elements are rotatable about selected orthogonally related axes to move the elements into predetermined

relationships. Horvath also appears to teach puzzles that would involve attributes of individual skill, as opposed to games of chance. Indeed, the entire disclosure of Horvath deals with improved mechanical operations of a RUBIK'S CUBE type puzzle, e.g., "... characterized by its ruggedness and ease of assembly and operation, low cost, attractive appearance ...." (see col 1:38-50 of Horvath).

The Office acknowledges that "Kaplan does not teach the fractional three-dimensional images having a height, a width and depth" (as required by Applicants claimed invention, independent claims 16 and 21). The Office contends that it would have been obvious to make the "combination of Kaplan and Horvath ...to have a gaming device with three-dimensional images ..." since Horvath allegedly teaches "fractional three-dimensional images having a height, width and depth."

However, Applicants submit that one of ordinary skill in the art, following the teaching of Horvath (dealing with an improved RUBIK'S CUBE game, i.e., a game of skill and not a game of chance) would have no incentive to incorporate only selected features of Horvath's improved game (such as fractional three-dimensional images) into the PYRAMID format slot machine game of Kaplan. Combining the two game formats would be incompatible, i.e., skill game versus game of chance, thus providing a disincentive to one of ordinary skill in the art to combine the two game formats, let alone suggesting selection of only one feature (such as fractional three-dimensional images) from one format for incorporation into the other format.

Accordingly, Applicants submit that a *prima facie* case of obviousness has not been established and respectfully request withdrawal of the rejection of independent claims 16 and 21 (and related dependent claims 17-19, 22-23, 25 and 26).

**4. Rejection of claims 7 and 8 under 35 USC §103(a) as being obvious over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Paulos (U.S. Patent No. 4,407,502).**

Claims 7 and 8 stand rejected under 35 USC §103(a) as being obvious over Lupo in view of Horvath and further in view of Paulos. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claim 1 (Section 2), from which claims 7 and 8 are dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since "... all the claim limitations must be taught or suggested by the prior art ..." (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

**5. Rejection of claims 9 and 15 under 35 USC §103(a) as being obvious over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Inoue (U.S. Patent No. 5,722,891).**

Claims 9 and 15 stand rejected under 35 USC §103(a) as being obvious over Lupo in view of Horvath and further in view of Inoue. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claim 1 (Section 2), from which claims 9 and 15 are dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since "... all the claim limitations must be taught or suggested by the prior art ..." (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

**6. Rejection of claims 10 and 11 under 35 USC §103(a) as being obvious over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Holmes, Jr. (U.S. Patent No. 5,720,662).**

Claims 10 and 11 stand rejected under 35 USC §103(a) as being obvious over Lupo in view of Horvath and further in view of Holmes, Jr. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claim 1 (Section 2), from which claims 10 and 11 are dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since "... all the claim limitations must be taught or suggested by the prior art ..." (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

**7. Rejection of claim 12 under 35 USC §103(a) as being obvious over Lupo (U.S. Patent Application Publication 2002/0111204) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Ikenaga (U.S. Patent Application Publication 2003/0067113).**

Claim 12 stands rejected under 35 USC §103(a) as being obvious over Lupo in view of Horvath and further in view of Ikenaga. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claim 1 (Section 2), from which claim 12 is dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since "... all the claim limitations must be taught or suggested by the prior art ..." (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

**8. Rejection of claims 20 and 24 under 35 USC §103(a) as being obvious over Kaplan (U.S. Patent No. 5,413,342) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Inoue (U.S. Patent No. 5,722,891).**

Claims 20 and 24 stand rejected under 35 USC §103(a) as being obvious over Kaplan in view of Horvath and further in view of Inoue. Applicants respectfully traverse the rejection.

Based on the discussion presented above regarding independent claims 16 and 21 (Section 3), from which claims 20 and 24 are dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since “... all the claim limitations must be taught or suggested by the prior art ...” (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

**9. Rejection of claims 27 and 28 under 35 USC §103(a) as being obvious over Kaplan (U.S. Patent No. 5,413,342) in view of Horvath (U.S. Patent No. 4,405,131) and further in view of Paulos (U.S. Patent No. 4,407,502).**

Claims 27 and 28 stand rejected under 35 USC §103(a) as being obvious over Kaplan in view of Horvath and further in view of Paulos. Applicants respectfully traverse the rejection.

Applicants note that the Office has provided no citations from Horvath or Paulos (to combine with Kaplan) to support the aforementioned rejection, but instead refer to a passage from Nakamura; however, Nakamura was not cited in the rejection. Applicants assume this was an error in transcription and rely on the argument presented below.

Based on the discussion presented above regarding independent claim 21 (Section 3), from which claims 27 and 28 are dependent, Applicant respectfully submits that a *prima facie* case of obviousness has not been established since “... all the claim limitations must be taught or

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suggested by the prior art ..." (see MPEP 2143.03). Therefore, Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

### **Conclusion**

Based on the arguments presented above, Applicants respectfully submit that the rejections have been overcome and request allowance of the claims. If the Office has any questions regarding the application or this response, the Office is encouraged to call Applicants' attorney, Ian F. Burns, at (775) 826-6160.

Respectfully submitted,

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